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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,254	11/19/2001	Shinichi Okamoto	441/1/005	7765

7590 08/29/2003
Richard M. Goldberg
Suite 419
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EXAMINER

WONG, EDNA

ART UNIT	PAPER NUMBER
1753	

DATE MAILED: 08/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/993,254

Applicant(s)

OKAMOTO ET AL.

Examiner

Edna Wong

Art Unit

1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 19 November 2001 is: a) ☒ approved b) ☐ disapproved by the Examiner
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Drawings

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on November 19, 2001 have been approved by the Examiner. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities:

page 7, line 2, "Fig. 7" should be amended to -- Fig. 7(a) --.

Appropriate correction is required.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

- I. Claims **1-6** are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for electroforming a *metal* onto the wire, does not

reasonably provide enablement for electroforming a *conductive polymer* (e.g., polypyrrole) onto the wire. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Claim 1, line 3, as presently claimed, recites "electroforming on a wire". This claim limitation encompasses electroforming any material. However, Applicants' specification discloses that metals are electroformed onto the wire (page 5, line 20 to page 6, line 20).

Thus, the claims are not commensurate in scope with the specification.

II. Claims **1-6** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1

line 9, the rod comprises the wire (from claim 1, lines 4). If the wire is drawn out, it is unclear how the rod is machined. It appears that it is just the electroformed material that is machined.

Claim 4

line 2, the word "type" is indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims **1-6** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ikeda et al.** (US Patent No. 4,290,857).

Ikeda teaches a method of manufacturing a part for an optical fiber connector, the method comprising the steps of:

(a) electroforming on a wire **1** used as a mother mold with the wire stretched (col. 2, lines 36-39) to make the wire into a rod **3**; and

(b) machining **5** (= grinding tool) the rod to adjust the diameter of the rod (= col. 2, lines 53-59; and Fig. 3)

One wire is used (col. 2, lines 30-35; and Fig. 1).

The wire is made from metal (= copper) [col. 2, lines 30-35].

Ikeda does not teach forming grooves on the rod at intervals to form groove portions; breaking the groove portions; drawing the wire; wherein a plurality of wires are used; for a multi-core type using cross-sections of the wire other than a circular cross-section; and wherein the wire is made from plastic.

However, the invention as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made because one skilled in the art would have been motivated to have modified the method of Ikeda with forming grooves on the rod at intervals to form groove portions; and breaking the groove portions because this would have been doing the same endeavor as Ikeda, who is slicing the electroformed rod by means of a cutting blade 6 (col. 2, lines 60-62; and Fig. 4). The substitution of one known equivalent technique for another may be obvious even if the prior art does not expressly suggest the substitution. *Ex parte Novak* 16 USPQ 2d 2041 (BPAI 1989); *In re Leshin* 125 USPQ 416; *Lyon v. Bausch & Lomb* 106 USPQ 1; *Graver Tank & Manufacturing Co. V. Linde Air Products Co.* 85 USPQ 328 (Supr. Ct.). MPEP § 2144.07.

Furthermore, forming a groove portion and breaking it does not appear to have been invented by the Applicants, unless proven otherwise.

As to drawing the wire, this would have been doing the same endeavor as Ikeda, who is dissolving and removing the core wire 1 (col. 3, lines 3-12). The substitution of one known equivalent technique for another may be obvious even if the prior art does not expressly suggest the substitution. *Ex parte Novak* 16 USPQ 2d 2041 (BPAI 1989); *In re Leshin* 125 USPQ 416; *Lyon v. Bausch & Lomb* 106 USPQ 1; *Graver Tank & Manufacturing Co. V. Linde Air Products Co.* 85 USPQ 328 (Supr. Ct.). MPEP § 2144.07.

Furthermore, drawing a wire does not appear to have been invented by the Applicants, unless proven otherwise.

As to wherein a plurality of wires are used, it is well within the skill of one having ordinary skill in the art to make the jig big enough to electroform more than one wire.

Furthermore, the duplication of parts was held to have been obvious. *In re Harza* 124 USPQ 378 and MPEP § 2144.04(f).

As for a multi-core type using cross-sections of the wire other than a circular cross-section, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

The claim limitation of "using cross-sections of the wire other than a circular cross-section" does not further limit the method steps of claim 1 and is not a method step itself which would make a manipulative difference in the method of manufacturing the part for the optical fiber connector.

Furthermore, this is well within the ordinary skill of the artisan to have used

cross-sections of the wire other than a circular cross-section dependent upon the intended use of the device, particularly to the environment to which the device will encounter (such as a medical device or a circuit device), which would be most suited for the application of the device, absent evidence to the contrary.

As to wherein the wire is made from plastic, this is well within the ordinary skill of the artisan dependent upon the intended use of the device, particularly to the environment to which the device will encounter (such as a medical device or a circuit device), which would be most suited for the application of the device, absent evidence to the contrary.

Furthermore, Ikeda teaches that various materials can be used as the material of the wire (col. 2, lines 30-35).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edna Wong whose telephone number is (703) 308-3818. The examiner can normally be reached on Mon-Fri 7:30 am to 5:00 pm, alt. Fridays off.

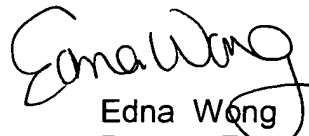
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (703) 308-3322. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or

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proceeding should be directed to the receptionist whose telephone number is (703) 308-1495.


Edna Wong
Primary Examiner
Art Unit 1753

EW
August 28, 2003